ESTTA Tracking number: **ESTTA115174**

Filing date: **12/18/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046058
Party	Defendant Medtronic, Inc. Medtronic, Inc. 710 Medtronic Parkway Minneapolis, MN 554325604
Correspondence Address	Dean R. Karau Fredrikson & Byron, P.A. 200 South Sixth StreetSuite 4000 Minneapolis, MN 554021425 UNITED STATES ip@fredlaw.com, dkarau@fredlaw.com
Submission	Reply in Support of Motion
Filer's Name	Dean R. Karau
Filer's e-mail	dkarau@fredlaw.com, ip@fredlaw.com
Signature	/Dean R. Karau/
Date	12/18/2006
Attachments	Medtronic MAXIMO Reply_Brief.pdf (12 pages)(975866 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Masimo Corporation, Petitioner, v. Medtronic, Inc., Registrant, and Medtronic, Inc. Counterclaim Petitioner, v. Masimo Corporation, Counterclaim Registrant.	)	Cancellation No. 92,046,058 Registration No. 2,916,730 Mark: MAXIMO

REGISTRANT'S REPLY MEMORANDUM OF LAW IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT DISMISSING PETITION TO CANCEL

Likelihood of confusion is a question of law, not fact, as Masimo suggests.

Masimo uses its mark with goods which monitor vital signs using signal processing technologies – they are not medical devices such as defibrillators, as Masimo suggests.

MAXIMO implantable defibrillators are used in chronic disease management, not in emergency response equipment, as Masimo suggests.

Such misdirection only creates general confusion, but lays no foundation for persuasive analysis on trademark confusion and dilution. And the analysis on both issues is straightforward.

There are no genuine issues of material fact, and on the basis of the first two *DuPont* factors alone, Medtronic, Inc. is entitled to summary judgment as a matter of law on Masimo's 2(d) claim.

The goods used with MAXIMO – *medical devices, namely implantable pulse generators and cardioverter defibrillators, component parts and fittings* – are dissimilar to the goods used with MASIMO – *in vivo patient monitors for detecting a physiological condition and electronic in vivo monitors; namely, blood monitors*. Moreover, the MASIMO and MAXIMO marks are dissimilar. Thus, based on both of the first two *DuPont* factors, summary judgment is appropriate as a matter of law.

Finally, Masimo has offered only conclusory and self-serving assertions that its mark is famous, insufficient to create the genuine issue of material fact needed to defeat summary judgment on its dilution claim. Furthermore, because of the dissimilarity of the marks – they are not identical, essentially the same or substantially similar – dilution cannot exist as a matter of law. Therefore, the Board should grant summary judgment to Medtronic, Inc. on Masimo's dilution claim as well.

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I. ARGUMENT

A. There Is No Likelihood of Confusion.

Contrary to Masimo's belief that the question of likelihood of consumer confusion is a question of fact, the ultimate question of confusion is one of law. *Sweats Fashions, Inc. V. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 U.S.P.Q.2d 1793 (Fed. Cir. 1987).

While there may be disputed factual issues, there are no genuine issues of any facts *material* to Medtronic, Inc.'s motion for summary judgment on Masimo's 2(d) claim.

1. The goods in the respective registrations are dissimilar.

Masimo does not dispute (1) that Medtronic Emergency Response Systems, Inc., fna Medtronic Physio-Control Corporation ("MERS"), is a corporation legally organized under the laws of the state of Washington; (2) that Masimo and MERS, not Medtronic, Inc., are in a contractual relationship in which Masimo's signal processing goods for noninvasive monitoring of patient vital signs are incorporated into MERS LIFEPAK automated *external* defibrillators used in emergency response equipment; (3) that Medtronic, Inc. is a corporation legally organized under the laws of the state of Minnesota; and (4) that Masimo's goods used in connection with its MASIMO mark are not incorporated into or sold in connection with the Medtronic, Inc. *implantable* goods aimed at long-term chronic disease management used in connection with its MAXIMO mark.[1] However, whether disputed or not, none of those are facts *material* to the dissimilarity of the parties' respective goods.

[1] In fact, on December 4, 2006, Medtronic, Inc. announced that it was spinning-off its MERS subsidiary, permitting Medtronic, Inc. to focus its resources on high-growth therapies aimed at chronic disease management, while permitting MERS to continue to focus on its core mission of developing state-of-the-art technologies in emergency response external defibrillators. *See*

The only issue for the dissimilarity of the goods are the goods themselves, those used in connection with the MASIMO mark, in vivo patient monitors for detecting a physiological condition and electronic in vivo monitors; namely, blood monitors,[2] and those used in connection

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http://wwwp.medtronic.com/Newsroom/NewsReleaseDetails.do?itemId=1165240775016&lang=en_US.

[2] Masimo, however, has confused the goods at issue through the sometimes confusing manner in which it describes its goods. For instance, on page 3 of its brief, Masimo accurately describes its goods as "monitoring technologies and products for monitoring of vital signs in connection with the MASIMO name and mark," which is consistent with the goods in its registrations.

However, in the next paragraph, Masimo confuses its goods with the goods into which its goods are incorporated: "Among the goods offered by Masimo *in connection with* its name and mark MASIMO are patient care devices that include Masimo SET signal processing technologies, including multi-measurement monitors, defibrillators and infant incubators." (Emphasis added.) As the Board knows, the term "in connection with" is a trademark term of art that means the trademark owner is claiming rights in the mark with respect to the designated goods. In this case, however, patient care devices such as multi-measurement monitors, defibrillators and infant incubators are not Masimo products and Masimo is not claiming rights with respect to those goods. (The next sentence in the paragraph attempts, albeit inartfully, to clarify that, by noting that "these devices [patient care devices such as multi-measurement monitor, defibrillators and infant incubators] are offered by various patient monitoring system providers.")

Also, in the Declaration of Charles Fowler in Support of Masimo Corporation's Opposition to Medtronic, Inc.'s Motion for Summary Judgment, there is similar confusion about Masimo's goods. In paragraph 3, Mr. Fowler avers that "[a]mong the goods offered by Masimo and/or its licensees in connection with the name and mark MASIMO are devices that include Masimo SET signal processing technologies, including multi-measurement monitors, defibrillators and infant incubators." (Once again, the next sentence attempts, albeit inartfully, to clarify the confusion.) Clearly, Masimo is not claiming it has trademark rights with respect to multi-measurement monitors, defibrillators and infant incubators.

Mr. Fowler also repeatedly uses the term "Medtronic, Inc. and/or its related entities" to describe the other party in the license agreement which results in Masimo's products being used in MERS' LIFEPAK products. As a person who has personal knowledge of the facts in the Declaration, Mr. Fowler should know that the parties' original agreement identifies Medtronic Physio-Control Corp. as the licensee, not "Medtronic, Inc. and/or its related entities," and that the new agreement which the parties are attempting to negotiate identifies Medtronic Emergency Response Systems, Inc. as the licensee, not "Medtronic, Inc. and/or its related entities." As a person with knowledge, Mr. Fowler also should know that MERS makes emergency response external defibrillators, while MAXIMO is used with implantable defibrillators as part of overall chronic disease management.

with the MAXIMO mark, medical devices, namely implantable pulse generators and cardioverter defibrillators, component parts and fittings.

The parties' respective goods are different. Masimo's MASIMO noninvasive in vivo blood monitoring devices are used for blood monitoring and are used externally on the body. In contrast, Medtronic's MAXIMO medical device is surgically implanted. The parties' respective products do not compete nor serve the same purpose. The relevant consumer would not reasonably think that Medtronic, Inc.'s surgically-implanted devices addressing heart failure come from Masimo. On this basis alone, even if the respective marks were identical, there is no likelihood of confusion.

2. MASIMO and MAXIMO are dissimilar.

Masimo has proffered no countering evidence *sufficient* to create genuine factual dispute on the issue of the dissimilarities of the marks. *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 U.S.P.Q.2d 1793 (Fed. Cir. 1987.) Even if other *DuPont* factors favored Masimo, which they do not, there is simply no genuine issue for trial about the likelihood of confusion. The instant matter is similar to *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (no confusion between CRISTAL and CRYSTAL CREEK), *Kellogg Co. v. Pack'em Enterprises*, 951 F.2d 330, 332-33, 21 USPQ2d 1142, 1144-45 (Fed. Cir. 1991) (no confusion between FROOTEE ICE and FRUIT LOOPS); and *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 48, 55 USPQ2d 1051, 1055 (2d Cir. 2000) (no confusion between DENTYNE ICE and ICE BREAKERS)..

Masimo has not met its burden to create a genuine factual dispute that would permit a reasonable fact finder to resolve the matter in its favor. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986); *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 U.S.P.Q.2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American*

Music Show, Inc., 970 F.2d 847, 23 U.S.P.Q.2d 1471 (Fed. Cir. 1992). Simply put, a reasonably minded trier of fact could not conclude that MASIMO and MAXIMO are similar.

Masimo does not dispute the letter "s" in MASIMO is pronounces "ess," while the letter "x" in MAXIMO is pronounced "ks."

Masimo also does not dispute that MAXIMO *could* connote the concept of "maximum" or an equivalent meaning. Masimo also does not dispute that MASIMO apparently has no meaning in the English language.[3] Thus, Masimo does not dispute that the marks also have different meanings.

With respect to commercial impression, Masimo does not dispute that MAXIMO *may suggest* "maximum," and does not dispute that MASIMO leaves no impression, let alone a similar impression. Thus, Masimo does not dispute that there are differences in the commercial impressions of the marks.

Consequently, although MASIMO and MAXIMO may share some syllables and letters, the marks, when considered in their entireties, are sufficiently different such that confusion is unlikely from contemporaneous use of the marks, even if the marks are used on identical goods marketed in the same trade channels to the same class of purchasers, which they are not.

Therefore, on the basis of the first two *DuPont* factors alone, the dissimilarity of the marks and the dissimilarity in the parties' respective and goods, the Board should find that Medtronic, Inc.'s MAXIMO mark is not confusingly similar to Masimo's MASIMO marks as a matter of law.

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[3] Masimo erroneously reaches the conclusion that Medtronic, Inc. believes the MASIMO mark is arbitrary or coined when, in fact, Medtronic, Inc. clearly stated that it was not <u>*presently*</u> aware of any meaning in the English language. Medtronic, Inc. Brief at 12. Medtronic, Inc. went on to say that it could be a coined term, a foreign term, a technical term or a surname. *Id.* Of course, Masimo is used worldwide as a surname, and also as a given name. In addition, Masimo is the name of a town in northern Sierra Leone, and likely has other meanings as well.

B. The MASIMO Mark is Not Famous and MASIMO and MAXIMO are Not Identical, Essentially the Same or Substantially Similar.

1. The MASIMO mark is not famous.

Masimo cannot demonstrate that its mark is famous among the general public today, let alone that it was famous before Medtronic, Inc. filed its application in 2003. *Advantage Rent-A-Car, Inc. v. Enterprise Rent-A-Car, Co.*, 238 F.3d 378, 380 (5th Cir. 2001) (second mark must be adopted after first mark had become famous).

Dilution is a claim "invented and reserved for a select class of marks – those marks with such powerful consumer associations that even non-competing uses can impinge on their value." *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999). To qualify as "famous," a mark must be "truly prominent and renowned." *Avery,* 189 F.3d at 875. Congress envisioned that a mark would qualify as famous under the Lanham Act only if the mark carried a "substantial degree" of fame. *TCPIP Holding Co., Inc. v. Haar Communications, Inc.*, 244 F.3d 88, 99 (2d Cir. 2001).

Moreover, on October, 26, 2006, the Trademark Dilution Revision Act of 2006, which amended 15 U.S.C. §1125, was signed. Under the amendment a mark is "famous" only " if it is widely recognized by the *general consuming public* of the United States as a designation of source of the goods or services of the mark's owner." *Id.* (emphasis added). Thus, Masimo's burden is now even greater, because the amendment eliminated "niche" fame such that, even if Masimo's mark was famous in a subset of the medical community, of which Masimo has no evidence, it would not longer qualify for dilution protection.

The only "fact" Masimo alleges in support of its claim of fame is that its mark has been in use for at least 12 years. However, Masimo's mark had thus only been in use for nine years as

of the date of Medtronic, Inc.'s application, and Masimo has proffered no evidence that its mark was famous as of 2003.

The only other support Masimo proffers is a conclusory and self-serving statement from one of its in-house attorneys that the mark has become well known. However, the attorney does not even define the set of the population in which its marked is allegedly well known. Moreover, mere conclusory statements do not take on dignity by placing them in affidavit form. *Sweats Fashions, Inc. V. Pannill Knitting Co., Inc.* 833 F.2d 1560, 4 U.S.P.Q.2d 1793 (Fed. Cir. 1987).

Neither the bare fact that Masimo had used its mark for nine years before Medtronic, Inc. filed its application, nor the statement from Masimo's in-house attorney is sufficient for Masimo to meet its burden to proffer countering evidence showing that there is a genuine factual dispute for trial on the fame of its mark. Simply put, on the evidence of record, a reasonable fact finder could not resolve the matter in favor of Masimo.

Masimo cannot establish that its MASIMO mark is famous. Even if Masimo's marks may have developed some distinctiveness in the pulse oximetry field, it has not reached the level of distinctiveness necessary to achieve fame before the general public. Because Masimo has not and cannot demonstrate that its marks have acquired the requisite fame, Medtronic, Inc. is entitled to summary judgment on the dilution claim.

2. MASIMO and MAXIMO are not identical, essentially the same or substantially similar.

Even if Masimo's mark qualified as a famous mark, dilution cannot exist as a matter of law because of the dissimilarity of the marks. Under dilution law, Masimo must prove more than confusing similarity; it must show that the marks are identical or very or substantially similar. *See Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (T.T.A.B 2001); see *also Nabisco, Inc. v. PF Brands Inc.*, 191 F.3d 208, 218, 51 USPQ2d 1882, 1889 (2d Cir. 1999); *Mead Data Central Inc.*

v. Toyota Motor Sales U.S.A., Inc., 875 F.2d at 1029, 10 USPQ2d 1961, 1966 (2d Cir. 1989) ("absent such similarity, there can be no viable claim of dilution"). The Trademark Dilution Revision Act of 2006 did not change that.

The MASIMO and MAXIMO marks are different in sight, sound and connotation or commercial impression. Therefore, even if Masimo's marks were famous, which they are not, there is no genuine issue that Masimo's marks are not diluted by Medtronic, Inc.'s use of its mark on the goods identified in its registration.

Medtronic, Inc. is entitled to summary judgment on Masimo's dilution claim.

III. CONCLUSION

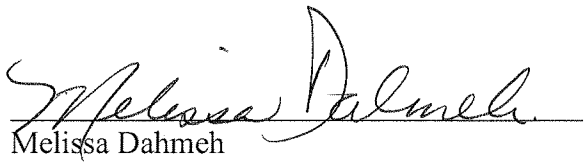
For the foregoing reasons, Medtronic, Inc. requests the Board grant its motion for summary judgment, dismissing the Petition to Cancel.

Dated: December 18, 2006

Dean R. Karau
FREDRIKSON & BYRON, P.A.
Suite 4000
200 Sixth Street South
Minneapolis, MN 55402-1425
(612) 492-7178
(612) 492-7077 (Fax)
IP@fredlaw.com
Attorneys for Registrant
Medtronic, Inc.

CERTIFICATE OF SERVICE

I hereby certify that true copies of the **REGISTRANT'S REPLY MEMORANDUM OF LAW IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT DISMISSING PETITION TO CANCEL** was served by United States mail on the attorney of record for Masimo in this action, Deborah S. Shepherd, Knobbe, Martens, Olson & Bear, LLP, 2040 Main Street, 14th Floor. Irvine, CA 92614, by mailing it to her address of record by first class mail, postage prepaid, this 18th day of December, 2006.



Melissa Dahmeh

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